

REMARKS

This paper is being contemporaneously filed with a Petition for a five month extension of time and an authorization to debit Deposit Account No. 50-1275 for the appropriate fees.

In response to the restriction requirement, **Applicants hereby elect Group V, claims 1-4 and 8-16**, with traverse. In doing so, Applicants reserve the right to pursue the subject matter of the non-elected claims in one or more divisional or continuing application(s).

The Office has required restriction among the six allegedly patentably distinct inventions below:

- I. Claim 17, drawn to compositions comprising the compound of claim 16.
- II. Claim 5, drawn to compositions identified by the method of claim 2.
- III. Claim 6, drawn to compositions identified by the method of claim 2.
- IV. Claim 7, drawn to compositions identified by the method of claim 2.
- V. Claims 1-4 and 8-16, drawn to a method for identifying a candidate compound as a compound selected from the group consisting of an inverse agonist, a partial agonist, and an antagonist to an endogenous, constitutively active GPCR fusion protein, classified in class 435, subclass 7.21.
- VI. Claims 18-19, drawn to a method for modulating G protein-coupled orphan receptor by contacting said receptor with compound identified by the method of claim 1, classified in class 435, subclass 7.21.

As will be appreciated, even if the Office considers the groups of claims to be patentably distinct, M.P.E.P. §803 mandates *two* criteria for a proper requirement for restriction: 1) the inventions must be independent or distinct; *and 2) there would be a serious burden on the examiner if restriction is not required.* For purposes of initial restriction, a serious burden on

the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in M.P.E.P. §808.02. Significantly, however, this *prima facie* burden has not been met.

The Office Action has not shown separate status in the art or a requirement for a different field of search – indeed, Groups V and VI are in the same class, class 435, and even the same subclass, subclass 7.21. Thus, it is not clear how searching these groups in the same class and subclass would place a serious burden on the examiner. Additionally, the claims of group VI are dependent upon independent claim 1 of group V. Any search for group VI necessarily includes the search for group V. For these reasons, we believe these groups should be rejoined.

Applicants respectfully assert that at a minimum, groups V and VI should be rejoined. Claims 18-19 of group VI depend directly or indirectly from independent claim 1 of group V and are classified in the same class and subclass.

Applicants respectfully assert that they have fully responded to the outstanding restriction requirement by electing the invention of group V, claims 1-4 and 8-16, with traverse. Reconsideration of the restriction requirement in light of the comments herein is respectfully requested.

The Commissioner is hereby authorized to charge any fee or underpayment thereof or credit any overpayment to deposit account no. 50-1275.

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Serial No. 10/668,035

December 20, 2006 Response
to June 29, 2006 Restriction Requirement

Early reconsideration and allowance of all pending claims is respectfully requested. The examiner is requested to contact the undersigned attorney if an interview, telephonic or personal, would facilitate allowance of the claims.

Respectfully submitted,

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